

### REMARKS

This paper is responsive to a Final Office Action mailed January 12, 2006. Prior to this response, claims 1, 4-14, and 17-25 were pending. After amending claims 1, 4-8, 11-14, 17-19, 21, and 23-25, and adding new claims 26-31, claims 1, 4-14, and 17-31 remain pending.

The Office Action states that claims 1, 4-6, 8-9, 12, 14, 17-18, 20-21, and 24-25 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to AuClair, in view of Takahashi (JP 07273957). The Office Action acknowledges that AuClair does not describe the allocation of RAM based upon MFP component, where the component can be a fax, copier, scanner, or printer. The Office Action states that Takahashi describes RAM allocation based upon MFP component, and that it would have been obvious for an expert to modify AuClair in view of Takahashi to allocate more memory between components, since the memory is shared between components. This rejection is traversed as follows.

An invention is unpatentable if the differences between it and the prior art would have been obvious at the time of the invention. As stated in MPEP § 2143, there are three requirements to establish a *prima facie* case of obviousness.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination

and reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck* 947 F.2d 488, 20 USPQ2d, 1438 (Fed. Cir. 1991).

In his Abstract and Summary (col. 2, ln. 19-48), AuClair describes a random access memory (RAM) for storing data in variably sized compartments, and a processor that generates compartment size allocation recommendations in response to source of the print jobs. At col. 8, beginning at ln. 6, AuClair describes a printer that is able to analyze and implement system 100 RAM functions related to printer operations. The various blocks in Fig. 1 show an analytical process that attempts to gauge future memory needs by reviewing the history of previous jobs, cross-referenced to input port (serial, parallel, and network). Decision block 130 permits a user to automatically change memory allocation, or display recommended allocations for user selection (col. 8, ln. 41-45).

The *Response to Arguments* Section of the Office Action states that Takahashi describes memory allocation on the basis of fax, scanner, printer, or copier function. While Takahashi's explanation of Fig. 2 describes a conventional fax/scanner machine, the Applicant is unable to find any description of memory being allocated between printer, copier, and scanner functions. To the best of the Applicant's understanding, Takahashi describes a fax machine that allocates memory for electronic sorting and fax functions (Abstract). The memory is managed so that the allocations can be revised in the event of storage shortages [97-107].

With respect to the first *prima facie* requirement, while motivation may exist to combine references based upon a more effective use of memory between MFP components, as suggested in the Office Action, this combination fails to suggest any modifications to AuClair that make the limitation of user-selected RAM allocation obvious. That is, no

analysis has been provided in the Office Action to show how Takahashi would suggest a modification to AuClair for the allocation of RAM based upon user interface selections.

Considered from the perspective of the second *prima facie* requirement, even if an expert were given the references as a foundation, there is no reasonable expectation for the implementation of user-selected RAM allocation, since neither reference presents such a limitation.

With respect to the third *prima facie* requirement, the combination does not describe all the limitations of the claimed invention. Claims 1 and 14 have been amended to more clearly recite that a user is able to allocate a percentage of RAM for a particular MFP component or document format. AuClair does not describe the limitation of RAM being allocated on the basis of MFP component (fax, scanner, printer, or copier). Takahashi appears to describe a machine that adjusts the allocation of memory between electronic sorting and fax functions when capacity becomes a problem. Therefore, the combination of Takahashi with AuClair does not explicitly teach the limitation of a user selecting a percentage of RAM allocation for an MFP component, as recited in claims 1 and 14. Neither does the Takahashi suggest any modifications to AuClair that would make these missing limitations obvious. Claims 4-6, 8-9, and 12, dependent from claim 1, and claims 17-18, 20-21, and 24-25, dependent from claim 14, enjoy the same distinctions from the cited prior art references and the Applicant requests that the rejection be removed.

The Office Action states that claims 7 and 19 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to AuClair, in view of Takahashi and Venkatraman et al. ("Venkatraman"; US 5,956,487). The Office Action acknowledges that neither AuClair nor

Takahashi describe a web server, but that Venkatraman does. The Office Action continues that it would have been obvious to modify the combination of AuClair and Takahashi, per Venkatraman, because of low cost, enhanced interface functions, and device management, which are AuClair's stated objectives. This rejection is traversed as follows.

As noted above, AuClair describes a printer that is able to predict memory needs based upon an analysis of the printer job source. The user is then presented with selectable memory allocation options. Takahashi describes a system that automatically adjusts the allocation of memory between fax and electronic sorting functions. Generally, Venkatraman describes a web access functionality that can be embedded in a device to improve access and the user interface (col. 2, ln. 33-41).

With respect to the first *prima facie* requirement, even if a motive exists for combining references, that motivation does not suggest a modification to that makes the claimed invention obvious. At best, the combination of references may suggest a web-accessible MFP with machine-driven or predetermined RAM allocation algorithms. Rather, the analysis should determine if there is any motivation in the Venkatraman reference to modify either Takahashi or AuClair in such a manner as to teach the claimed invention. However, no such analysis has been provided in the Office Action, and the Venkatraman reference suggests no such modification.

Considered from the perspective of the second *prima facie* requirement, even if an expert were given the AuClair, Takahashi, and Venkatraman inventions as a foundation, there is no reasonable expectation that this expert could derive the claimed invention, since none

of the references describe an invention where the user selects a percentage of RAM allocation based upon MFP component.

With respect to the third *prima facie* requirement, even if an expert would be motivated to combine the three references, the combination does not describe all the limitations of the claimed invention. As noted above, neither Takahashi nor AuClair describe the limitations of a user selecting the percentage of RAM being allocated on the basis of MFP component or document format. Venkatraman does not teach anything to do with an MFP or RAM allocation. Therefore, the combination of Venkatraman, Takahashi, and AuClair does not explicitly teach a user selecting the percentage of RAM allocation based upon MFP component, as recited in claims 1 and 14. Neither does the Venkatraman suggest any modifications to AuClair or Takahashi that would make these limitations obvious. Claim 7, dependent from claim 1, and claim 19, dependent from claim 14, enjoy the same distinctions from the cited prior art references and the Applicant requests that the rejection be removed.

The Office Action states that claims 10 and 22 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to AuClair, in view of Takahashi and Mahmoud et al. ("Mahmoud"; US 6,785,746). The Office Action acknowledges that the combination of AuClair and Takahashi does not describe a user rebooting the system to assign memory, but that Mahmoud describes computer rebooting. The Office Action continues that it would have been obvious to modify AuClair in light of Mahmoud, because rebooting would load the system configuration in RAM, which is a feature demanded by AuClair. This rejection is traversed as follows.

Generally, Mahmoud describes the control of a peripheral device using a multi-channel SCSI chip. At col. 9, ln. 20-24, Mahmoud states that his computer must be rebooted to input data in EEPROM memory. With respect to the first and second *prima facie* requirements, it is not apparent how Mahmoud's treatment of computer rebooting has any relevance to a system that predicts memory allocation based on an analysis of input port (AuClair), or a system that adjusts memory allocation between electronic sorting and fax functions (Takahashi). Once again, even if a motive can be found to combine references, the combination does not suggest a modification that makes the Applicant's user-selected RAM allocation obvious.

With respect to the third *prima facie* requirement, even if an expert would be motivated to combine the three references, the combination does not describe all the limitations of the claimed invention. As noted above, neither Takahashi nor AuClair describe the limitation of a user selecting a percentage of RAM on the basis of MFP component. Mahmoud does not teach any details in the art of MFPs or discuss the subject of RAM allocation. Therefore, the combination of Mahmoud, Takahashi, and AuClair does not explicitly describe the user selection of a percentage of RAM allocation based upon MFP component or document format, as recited in claims 1 and 14. Neither does the Mahmoud suggest any modifications that would make these limitations obvious. Claim 10, dependent from claim 1, and claim 22, dependent from claim 14, enjoy the same distinctions from the cited prior art references and the Applicant requests that the rejection be removed.

The Office Action states that claims 11 and 23 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to AuClair

and Takahashi, in view of Bitar et al. ("Bitar"; US 6,353,844). The Office Action acknowledges that neither Takahashi nor AuClair describe MFP functions being prioritized in the event of memory contention. However, the Office Action states that Bitar describes CPU and memory resources that can be allocated for each batch job (col. 11, ln. 32). The Office Action continues that it would have been obvious to modify the combination of Takahashi and AuClair in light of Bitar because allocating resources to higher priority functions would improve the printer response time. This rejection is traversed as follows.

With respect to the first and second *prima facie* requirements, it is not apparent how Bitar's allocation of resources on the basis of batch job suggests any modifications to AuClair's memory allocation, which is based on an analysis of input port, or to Takahashi's memory allocation, which is adjusted on the basis of need. Again, even if a motive can be found to combine references, the combination does not suggest the Applicant's user-selected RAM allocation.

With respect to the third *prima facie* requirement, even if an expert would be motivated to combine the three references, the combination does not describe all the limitations of the claimed invention. Neither Takahashi nor AuClair describe the limitations of a user selecting the percentage of RAM being allocated on the basis of MFP component or document format. Neither does Bitar teach any details in the art of MFPs or discuss the subject of RAM allocation. Therefore, the combination of Bitar, with AuClair and Takahashi, does not explicitly teach a user selecting a percentage of RAM allocation based upon MFP component, as recited in claims 1 and 14. Neither does Bitar suggest any modifications to AuClair or Takahashi that would make these limitations obvious.

Claim 11, dependent from claim 1, and claim 23, dependent from claim 14, enjoy the same distinctions from the cited prior art references and the Applicant requests that the rejection be removed.

It is believed that the application is in condition for allowance and reconsideration is earnestly solicited.

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Respectfully submitted,

  
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